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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/434,645	11/05/1999	DAVID B. LOEPER	D5009-00002	4199

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EXAMINER

KYLE, CHARLES R

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 03/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



# Office Action Summary

Application No.

09/434,645

Applicant(s)

LOEPER, DAVID B.

Examiner

Charles R Kyle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.



## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 2, 8 and 14 recites the limitation "the result" in line 1 of each claim.. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims recite no feature which places the claimed inventions within the technological arts. No particular technological element such as a computer is claimed.

Claims 1-21 are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility. They recite elements of initialization and manipulation of values for a computation but produce no usable, specific result.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –



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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-2, 4-5, 7-8, 10-11, 13-14, 16-17 and 19-20** are rejected under 35 U.S.C. 102(b) as being anticipated by *Bierwirth*.

**As to Claim 1**, *Bierwirth* disclose the invention as claimed, including in a method for evaluating financial plans (Abstract) the steps of:

Receiving from a user financial plan information, comprising a predetermined initial value of an investment (page 2, lines 31-32), at least one predetermined contribution amount at a predetermined contribution time (page 3, line 17), at least one predetermined withdrawal amount at a predetermined withdrawal time subsequent to the predetermined contribution time (page 2, lines 24-26) and a plan duration (page 2, lines 25-26).

Selecting a first historical commencement date for a simulation of performance of a financial plan consistent with financial plan information (Page 3, lines 24-26);

Using historical market data commencing from said historical commencement date, calculating the changes in said predetermined initial value of an investment for each time period in one or more series of successive historical time periods (Page 3, lines 35-38);

Selecting a plurality of second historical commencement dates and repeating the foregoing steps of calculation commencing with each of said second historical commencement dates (Page 3, lines 29-32).

**With respect to Claims 7 and 13**, *Bierwirth* discloses the use of a computer system, which inherently uses a storage medium for executable instructions. See *Bierwirth* at page 3, lines 7-9.



Additionally, the steps of receiving initial investment, contributions, withdrawals and a plan duration cannot confer patentability because the replicate the steps involved in the retirement ledger disclosed by *Bierwirth* at page 1, line 16 to page 2, line 51. The concepts recited here are similar to those of another well-known financial activity, balancing a checkbook at the end of the month.

**Concerning Claims 2, 8 and 14**, *Bierwirth* discloses the presentation of results at page 2, line 53 to page 4, fourth full paragraph..

**As to Claims 4, 10 and 16**, *Bierwirth* disclose comparison of results of calculation to a goal at page 2, lines 31-41.

**Concerning Claims 5, 11 and 17**, *Bierwirth* discloses adjustment for taxes at pages 5-6, "A Word About Taxes".

**As to Claim 19**, *Bierwirth* discloses identification of time intervals at result presentation at page 3, lines 21-33.

**Concerning Claim 20**, *Bierwirth* disclose having as a goal a specified sum after a number of years at page 2, lines 31-35.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.



**Claims 3, 6, 9, 12, 15, 18 and 21** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Bierwirth et al* in view of *Jones et al*.

**Regarding Claims 3, 9 and 15**, *Bierwirth* discloses the invention substantially as claimed. See the discussions set forth above. *Bierwirth* does not specifically disclose allocation to more than one asset category. *Jones et al* disclose multiple asset categories and distinct historical data at Fig. 4 and Col. 12, line 54 to Col. 13, line 41. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the multiple asset categories of *Jones* in the invention of *Bierwirth* because this would have allowed investors to flexibly study varying combinations of investments in an attempt to maximize return on investment.

**With respect to Claims 6, 12 and 18**, *Jones et al* teach the entry of initial investment values and allocation to asset categories at Col. 5, line 50 to Col. 7, line 10.

**Regarding Claim 21**, *Jones et al* disclose changing an asset allocation after a selected number of time intervals and using a changed allocation in subsequent calculations at Col. 12, lines 24-28.

#### ***Response to Arguments***

Applicant's arguments with respect to claims 1-21 have been considered but are moot in view of the new ground(s) of rejection.



***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles R Kyle whose telephone number is (703) 305-4458. The examiner can normally be reached on M-F 6:00-2:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent A. Millin can be reached on (703) 308-1065. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9326 for regular communications and (703) 872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



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crk

March 20, 2003



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